

Remarks:

Reconsideration of the application, as amended herein, is respectfully requested.

Claims 1 - 18 and 20 - 22 are presently pending in the application. Claims 1 - 16 and 21 have been amended. Claim 19 was previously canceled.

In item 2 of the above-identified Office Action, claims 1 - 2, 5, 7 - 8, 10 - 18 and 20 - 22 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U. S. Patent No. 6,058,844 to Niemiec ("**NIEMIEC**") in view of U. S. Patent No. 4,508,033 to Fischer ("**FISCHER**"), U. S. Patent No. 3,238,869 to West et al ("**WEST**") and U. S. Patent No. 3,875,682 to Justus et al ("**JUSTUS**"). In item 3 of the Office Action, claims 3 - 4 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **NIEMIEC** in view of **FISCHER**, **WEST** and **JUSTUS**, and further in view of U. S. Patent No. 6,550,390 to Frankenberger ("**FRANKENBERGER**"). In item 4 of the Office Action, claims 6 and 9 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **NIEMIEC** in view of **FISCHER**, **WEST** and **JUSTUS**, and further in view of U. S. Patent No. 5,913,471 to Makosch et al ("**MAKOSCH**").

Applicant respectfully traverses the above rejections.

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More particularly, Applicant reiterates and incorporates, by reference, the arguments made in the response to the previous Office Action, with regard to why the present claims are believed to be patentable over the combination of references cited in the Office Action. In response to Applicant's arguments, pages 7 - 8 of the Office Action stated, in part:

In response to Applicant's argument that the conventional tensile stress for a printing path is about $470 \approx 500$ N/m, there is no reference to any outside source beyond applicant's disclosure of this figure. Furthermore, as discussed in the above rejection, **one having ordinary skill in the art would recognized that an optimal tensile stress would vary dependent upon the type of material used in the web. For example, a thin, paper web would react very differently to stress from a heavy, textile fabric.** Therefore, applicant's arguments would appear to be based upon specific process limitations not included in the claims. [emphasis added by Applicant]

To make Applicant's claimed invention even more clear, taking into consideration the comments made in the Office Action, Applicant has amended the independent claims to recite, among other limitations, that the machine in question is a web-fed rotary printing press, and that the web fed through the printing press is a paper web. For example, Applicant's claims 1 and 7 were amended to recite, among other limitations:

A web-fed rotary printing press, comprising:

at least one press cylinder for printing a paper web;
[emphasis added by Applicant]

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Similarly, Applicant's independent claim 14 was amended to recite, among other limitations:

A method for treating a printing material web in a **web-fed rotary printing press**, which further comprises:

feeding a paper web to a press cylinder under a first tensile stress; [emphasis added by Applicant]

These amendments to Applicant's claims are supported by the specification of the instant application, for example, on page 2 of the present application, lines 1 - 4, which state:

In **web-fed rotary offset presses**, a paper web is usually unwound from a supply roll and guided through a number of **printing units**, which print the web, normally on both sides and in many colors, in a wet offset process. [emphasis added by Applicant]

See also, for example, page 16 of the instant application, lines 3 - 12, which state:

Referring now to the figures of the drawing in detail and first, particularly, to Fig. 1 thereof, there is shown a diagrammatic, sectional view of a **machine 1 according to the invention, in this case a web-fed rotary offset press**.

The machine 1 contains a roll changer 2 with a supply roll 3 of a **printing material web 4, preferably a paper web**. The web 4 is unwound in the roll changer 2 and, toward the end of unwinding the roll 3, can be joined to a new web, on-the-fly or at a standstill. [emphasis added by Applicant]

As such, Applicant's amended claims make it clear that the tensile stresses applied to the web are being applied to a

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paper web of a web-fed rotary printing press. A person of ordinary skill in this art knows that the tensile stress of a paper web of a web-fed rotary printing press is, conventionally, in the range between 470 - 500 N/m. See, for example, page 24 of the instant application, lines 21 - 23.

However, the web-fed rotary printing press of Applicant's claims requires the tensile stress of the web downstream of the dryer to be considerably reduced compared with the upstream tensile stress, with the downstream tensile stress being less than 50 N/m. For example, claim 1 recites, among other limitations:

a pull roll disposed downstream of said dryer for conveying the paper web along said path with a given tensile stress that is considerably lower than a tensile stress in a printing path upstream of said at least one press cylinder, said given tensile stress being less than 50 N/m; [emphasis added by Applicant]

Similarly, Applicant's independent claim 7 recites, among other limitations:

a first pull roll disposed downstream of said dryer to convey the paper web along the path with a given tensile stress which is considerably lower than a tensile stress in a printing path upstream of said at least one press cylinder, said given tensile stress being less than 50 N/m; [emphasis added by Applicant]

Additionally, Applicant's independent claim 14 recites, among other limitations:

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**setting a second tensile stress of the paper web,
being considerably reduced as compared with the first
tensile stress, along the drying path, the second
tensile stress being less than 50 N/m [emphasis added
by Applicant]**

As such, Applicant's claims require, among other limitations, that the tensile stress of the **paper** web downstream of the dryer be considerably reduced compared with the upstream tensile stress (and with conventionally used tensile stresses on paper webs used in web-fed rotary printing presses), **the downstream tensile stress being less than 50 N/m**. The above limitations of Applicant's claims, among others, are not rendered obvious by the combination of **NIEMIEC** in view of **FISCHER, WEST** and **JUSTUS**, as alleged in the Office Action. Rather, as discussed in the response to the prior Office Action, the combination of **NIEMIEC** and **FISCHER** (as well as, in combination with **WEST** and **JUSTUS**) made in the Office Action would specifically teach a person of ordinary skill in this art **away** from using a second tensile stress of less than 50 N/m, and thus, would specifically **teach away** from Applicant's claimed invention.

Because, conventional devices use a stress of about 470 - 500 N/m, and because the disclosure of **FISCHER** requires the **tension of the web inside the dryer to be kept at about the same level as inside the printing units**, the tension of the

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web in the dryer of **FISCHER** would be understood by a person of ordinary skill in the art to be about 470 - 500 N/m. However, contrary to what would be understood by a person of skill in this art in view of **FISCHER** and **NIEMIEC**, Applicant's independent claims clearly require, among other limitations, **that the tensile stress of the web downstream of the dryer be less than 50 N/m**, which is about one tenth of the tensile stress of the web in the upstream printing units.

In response to the above-argument of Applicant, item 5 of the Office Action stated, in part:

In response to applicant's argument that the combination of Niemiec and Fischer would teach away from using a second tensile stress of less than 50 N/m, because the structure of Fischer always requires a comparatively high web tension and must be kept at about the same level in the dryer as in the printing units, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. [citation omitted by Applicant] In this case, the claim is rejected over the combined teachings of Niemiec, Fischer, West et al and Justus et al. and any arguments with respect to the reduced tensile stress and issues concerning separation of the web from the cylinders must take into account the teachings of West et al. and Justus et al. One having ordinary skill in the art would recognize the advantages of combining all of these references and would be capable of the modifications necessary to realize these advantages.

Applicant respectfully disagrees. First, it can be seen from page 4 of the Office Action that **none of NIEMIEC, FISCHER, WEST and JUSTUS** disclose reducing the tensile stress on a

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paper web to less than 50 N/m along the drying path, as required by Applicant's claims. As such, the combination of references cited in the Office Action fails to teach or suggest all limitations of Applicant's claims.

Second, MPEP § 2143.01(V) clearly states that the proposed modification cannot render the prior art unsatisfactory for its intended use. See, for example, MPEP § 2143.01(V) ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)"). However, in order to combine the alleged teaching of **JUSTUS** of "an apparatus for driving a pull roll for a web at a rotational speed being reduced as compared to a rotational speed of a press cylinder" in order to set the tensile stress to be lower than the tensile stress in the printing path, one must destroy the requirement of the **FISCHER** reference, rendering the prior art unsatisfactory for its intended use, contrary to MPEP § 2143.01(V).

More particularly, the provision of an ink tack between the blanket cylinders 14 and 15 of **FISCHER**, and the freshly printed web represents an essential feature of the apparatus of **FISCHER**. It is a goal of **FISCHER** to use the ink tack such

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that, in the event of a web break, the tack of the fresh ink on the rubber blankets 16, 17 of **FISCHER** promotes the torn paper web to wrap itself immediately about one of the cylinders. See, for example, col. 3 of **FISCHER**, lines 49 - 56, which state:

Upon the occurrence of a tear in the web, there is no delay in the paper web capturing apparatus according to the invention, because the cylinders 14, 15 acting as capturing cylinders are continuously in engagement with one another, and the torn paper web can thus wrap itself immediately about one of the cylinders, an action which is further promoted by the fresh ink on the rubber blankets 16, 17. [emphasis added by Applicant]

As such, the **FISCHER** reference discloses to a person of ordinary skill in this art that the resulting ink tack is an advantage. Keeping in mind this essential feature of **FISCHER**, a person skilled in the art will immediately recognize that when installing the web catching apparatus 12 of **FISCHER** in the press of **NIEMIEC**, the tension of the web inside the dryer must be at least the same or even higher than the web tension in the printing units, in order to peel the web off the rubber blankets 16, 17. In other words, when installing the apparatus 12 of **FISCHER** in the press of **NIEMIEC**, a person of ordinary skill in this art will recognize that the tension of the web inside the dryer has to be kept at about the same level as inside the printing units in order to provide the desired torn web "capturing function" of **FISCHER**, even during

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the normal printing operation. However, in adding the teachings of the **JUSTUS** reference (and/or **WEST**) to the combined teachings of **NIEMIEC** and **FISCHER** requires the elimination of the essential feature of FISCHER that the tension of the web inside the dryer has to be kept at about the same level as inside the printing units. Thus, in order to combine **JUSTUS** with **NIEMIEC**, **FISCHER** and **WEST**, in the manner suggested on pages 3 - 4 of the Office Action, one would have to, necessarily, sacrifice an essential feature of **FISCHER** (i.e., the torn web "capturing function" disclosed in col. 3, lines 49 - 67 of **FISCHER**). This would make the **FISCHER** device, as well as the resultant combined device of the rejection, unsatisfactory for its intended purpose, which is not permitted, according to MPEP § 2143.01(V). Put quite simply, the combination made in the Office Action would, necessarily, eliminate the torn web "capturing function" affirmatively taught in **FISCHER**, and thus, would impermissibly "render the prior art invention being modified unsatisfactory for its intended purpose"

As such, the combination of **FISCHER**, **NIEMIEC**, **WEST** and **JUSTUS**, made in the Office Action, cannot be used to render obvious Applicant's claims.

Further, item 5 of the Office Action stated, in part:

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In response to applicant's argument that the conventional tensile stress for a printing path is around 500 N/m, **there is no reference to any outside source beyond applicant's disclosure of this figure.** [emphasis added by Applicant]

Applicant respectfully disagrees. It is part of the general knowledge in this art that, in web-fed printing presses printing on paper, as presently claimed by Applicant, i.e., in which the printing material is printed by at least one printing cylinder and dried in a dryer, **the average web tension in the printing section always has to be in the range of 500 N/m in order to obtain a reasonable printing quality.** As such, the understanding of a person of ordinary skill in the art of web-fed rotary printing presses printing on a running paper web, upon reading the cited combination of prior art references, would not receive any teaching or suggestion to reduce the web tension in the drying section to less than 50 N/m, as required by Applicant's claims. As such, Applicant's claims are believed to be patentable over the cited prior art, whether taken alone, or in combination.

For the foregoing reasons, among others, the **FISCHER** and **NIEMIEC** references, in combination, not only **fail** to teach or suggest a limitation of Applicant's claims, but the combination also teaches away from Applicant's claims. The combination of **FISCHER**, **JUSTUS**, **WEST** and **NIEMIEC** absolutely

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teaches away from the above limitation of Applicant's independent claims. Further, the **GREGORY, FRANKENBERGER** and **MAKOSCH** references do not cure the above-discussed deficiencies of the **FISCHER, JUSTUS, WEST** and **NIEMIEC** references.

It is accordingly believed that none of the references, whether taken alone or in any combination, teach or suggest the features of claims 1, 7 and 14. Claims 1, 7 and 14 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 1, 7 or 14.

In view of the foregoing, reconsideration and allowance of claims 1 - 18 and 20 - 22 are solicited.

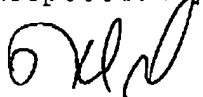
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

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If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Sterner LLP, No. 12-1099.

Respectfully submitted,



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